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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,833	09/19/2003	Bruno Borsoi	P24138	4888

7055 7590 10/14/2005

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RESTON, VA 20191

EXAMINER
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STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

10/664,833

**Applicant(s)**

BORSOI, BRUNO

**Examiner**

Anthony Stashick

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The amendment filed July 27, 2005 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the additions to paragraphs 0056 and 0067 specifying that the rear keepers are affixed to the inner surface of the outer envelope. There was no support for this in the application as originally filed. Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-5, 9-12, 14-17, 20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/37782 (WO '782). WO '782 discloses all the limitations of the claims including the following: an external sole (portion skate wheels is mounted to) and an upper 12; the boot extending longitudinally between a heel and a tip (see Figure 1); the upper including an outer envelope 12 and an inner envelope 14; the outer envelope being affixed to the external sole (see Figures 2 and 3); a mechanism 20, 18, 24 for tightening the inner envelope; the mechanism for tightening the inner envelope including keepers 24 affixed to the inner envelope and at least

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one lace 20; the mechanism for tightening the inner envelope further including at least one rear keeper 18 affixed to the outer envelope; the rear keeper being located substantially in an area of the heel of the boot (see Figure 3), the lace extending through the at least one rear keeper and through a plurality of keepers affixed to the inner envelope (see Figure 1); the outer envelope and the inner envelope are connected to one another by respective bases (when inner envelope is inserted in outer envelope as shown in Figure 1); the inner envelope is a liner removably mounted within the outer envelope (see Figure 1); the at least one rear keeper 18 comprises two rear keepers; one of the two rear keepers being located on the lateral side on the lateral quarter of the outer envelope (see Figure 3); another of the two rear keepers being located on the medial side on the medial quarter of the outer envelope (see Figure 3); the upper includes a lower portion provided to surround the foot and an upper portion provided to surround a portion of a user's lower leg (see Figure 1); at least one rear keeper is affixed to the outer envelope in the area of the heel of the boot (see Figure 1); the at least one rear keeper is affixed to an inner surface of the outer envelope in the area of the heel of the boot (eyelet affixed to both inner and outer surfaces as eyelets typically are); the outer envelope is relatively flexible (can move when opening and tightening); the mechanism retains the wearer's foot with respect to both the inner and outer envelopes (see page 6, lines 12-18); the upper includes a lower portion provided to surround the wearer's foot and an upper portion provided to surround a portion of the wearer's lower leg (see Figures 1-3); the at least one keeper is affixed to an inner surface of the outer envelope in the area of the heel of the boot (see Figures 1-3, eyelet fastened to both inner surface and outer surface).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6-8, 13 and 23 are rejected under 35 U.S.C. 103(a) as being obvious over WO 98/37782 as applied to claim 1 above. WO '782 discloses all the limitations of the claims except for the location of the straps used to make the keepers and the outer envelope being affixed to the external sole by adhesive or stitching. WO '782 teaches that keepers, such as that shown as 22, can be made of straps that are made into loops by being folded. WO '782 also teaches that the keepers on the outer envelope can be located above the heel and forward of the heel (see 18 near 22 in Figure 1). Furthermore, the outsole of WO '782 is injection molded with the out shell as is known in the art. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the keepers on the outer envelope of the shoe of WO '782 out of straps folded over to form loops and mounted on the outer envelope forward and above the heel to allow for greater adjustability of the tightness or looseness of the outer envelope due to the length of the straps. Furthermore, it would have been obvious to make the outer sole and upper out of multiple pieces fastened together as it is well known to make, in one piece, what was previously made in multiple pieces and fastened together.

6. Claims 6-8, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/37782 as applied to claim 1 above in view of Barret 5,940,990. WO '782 discloses all the limitations of the claims except or the keepers being made of straps (V-shaped) folded over to

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form loops. Barret '990 teaches that keepers 36 can be formed of straps that are folded over to form loops (also V-shaped). These keepers can be located in front of and above the heel of the shoe. The extra length of the straps would allow for more versatility in the tightening of the boot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the keepers of the boot of WO '782 out of folded over straps, as taught by Barret '990, to allow for more adjustability for the tightening of the boot to the user's foot.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/37782 as applied to claim 1 above in view of Maccano 4,822,500. WO 98/37782 as applied to claim 1 above discloses all the limitations of the claim except for an insole being affixed to the bases of the envelopes. Maccano '500 teaches that an insole can be located within the inside of a shoe and abut against the base of the envelopes of the upper of the shoe to give support to the user's foot and aid in cushioning the user's foot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place an insole within the boot of WO '782 as applied to claim 1 above, to give the user's foot support and cushioning.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/37782 as applied to claim 14 above, in view of Basso et al. 6,405,457. WO '782 discloses all the limitations of the claim except for the keepers affixed to the inner envelope having a plurality of keepers affixed to the upper portion of the inner envelope. Basso et al. '457 teaches that an inner envelope 20 can have keepers attached to the upper portion to aid in tightening the envelope to the user's lower leg. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to attach keepers, such as those used on the lower portion of the

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inner envelope of WO '782, to the upper portion of the envelope, as taught by Basso et al. '457, to aid in tightening the inner envelope to the user's lower leg.

### *Response to Arguments*

9. Applicant's arguments filed July 27, 2005 have been fully considered but they are not persuasive. Applicant argues that the keepers of WO '782 are not located in the heel area. Clearly, WO '782 shows the keepers located "in and area of the heel of the boot" (see Figures 1 and 3). Part of the heel is located in the area where the rearmost keeper is located and therefore, this limitation is met by WO '782. Applicant further argues that WO '782 does not show the straps in V-shaped loops. WO '782 clearly shows a loop 22 shown as a V-shape (the legs of the loop and the portion connecting the legs together). Applicant's other arguments are moot based upon the rejections set forth above.

### *Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

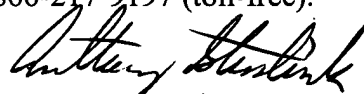
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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS